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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,413	11/14/2001	Yoshifumi Iida	111115	7047

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EXAMINER

RODEE, CHRISTOPHER D

ART UNIT	PAPER NUMBER
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1756

DATE MAILED: 01/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/987,413

Applicant(s)

IIDA ET AL.

Examiner

Christopher D RoDee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/17/03 & 1/2/04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-15,18 and 19 is/are pending in the application.
- 4a) Of the above claim(s) 18 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

Claims 18 and 19 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected method, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 5. The restriction remains FINAL for the reasons given in the Office action of 25 March 2003.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 2, 6, 7, 9-11, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakashita *et al.* in US Patent 4,985,327 in view of Watanabe *et al.* in US Patent 4,956,258 and further in view of Fujii *et al.* in US Patent 4,855,204.

Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakashita *et al.* in US Patent 4,985,327 in view of Watanabe *et al.* in US Patent 4,956,258 and further in view of Fujii *et al.* in US Patent 4,855,204 as applied to claims 1, 2, 6, 7, 9-11, and 13 above, and further in view of Iida *et al.* in US Patent 5,922,500.

Claims 5 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakashita *et al.* in US Patent 4,985,327 in view of Watanabe *et al.* in US Patent 4,956,258 and further in view of Fujii *et al.* in US Patent 4,855,204 as applied to claims 1, 2, 6, 7, 9-11, and 13 above, and further in view of *Handbook of Imaging Materials* to Diamond, pp. 179-181 & 222-224.

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Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakashita *et al.* in US Patent 4,985,327 in view of Watanabe *et al.* in US Patent 4,956,258 and further in view of Fujii *et al.* in US Patent 4,855,204 as applied to claims 1, 2, 6, 7, 9-11, and 13 above, and further in view of Vail in US Patent 5,994,015.

These rejections were set forth in the last Office action. The claims are unamended and thus have the same scope of protection as previously considered. The *prima facie* case of obviousness set forth in the previous Office action is incorporated here because it is still applicable to the instant claims. Applicants are not understood to have specifically traversed the rejection on the combinability of the references. Rather, applicants traverse based on the declarations of record. Applicants have filed executed declarations and supporting arguments in two separate requests for reconsideration. A telephone interview was conducted after submission of the first declaration and first request for reconsideration. Before the interview Applicants asked the Examiner to review the first response and declaration submission.

During the interview the Examiner expressed concern that the declaration did not show an unexpected result for the claimed toner and developer because it was unclear if the differences in the shielding property (transmission density) were significant because results were presented only as being "good" or "poor". Although the evaluation was based on a numerical measurement (see Evaluation, dec. p. 2), the results were presented as the qualitative "good" or "poor". It was unclear if the differences noted in Table A were significant because a slight numerical difference could equate to different qualifiers. For example, black image evaluations with a shielding properties of 1.29 and 1.30 would give different qualifiers, yet the numerical difference is small and might not be significant. It was also unclear how the shielding property was measured for cyan because only white and black evaluations were described. The Examiner also noted that the cyan image gave a "good" shielding property, the

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same as the inventive toners. It was unclear how the claimed white toner had an unexpected result over the prior art represented by the cyan toner because both gave an acceptable result in terms of the present invention. These observations are incorporated here as a response to the first request for reconsideration.

Applicants have submitted a second request for reconsideration and second executed declaration addressing the concerns presented by the Examiner in the interview. The request for reconsideration relies on the declaration for its traversal.

The Examiner has carefully considered this response and notes that the second declaration specifies the numerical values for shielding property in Table A. Declarant has newly specified that the two-layer shielding property evaluation recognizes a value of 1.6 or higher as "good". This appears to be a new evaluation criterion for the instant invention although. The Specification examples only measure the shielding property for white and black images formed from a single color toner (see spec. pp. 39-43). It is unclear to the Examiner why the evaluation criterion is different for the two-layer image (1.6 or higher is good) than for the black toner image (1.30 or higher is good). The specification does discuss having a layer of black toner and a layer of white toner (spec. p. 31). The specification does not indicate that the evaluation criteria are different for this combination than for the single black toner layer. Declarant has not specified why this different shielding criterion was used and unclear why this criterion is significant to image evaluation, particularly because it is greater than the black image alone. The evaluation of the black image represents no transmission of light. A bilayer image comprising black and another color would presumably have the same degree of shielding as the black image because it represents an image that blocks light through the OHP film. It is thus unclear why the evaluation criterion is different for the two-layer construction.

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The Examiner also finds the declaration insufficient because it is unclear what criterion is used for the cyan toner image. The recent declaration, like the first declaration, does not specify the cyan evaluation criterion/criteria.

The declaration is also not persuasive because the Rule 132 declaration is not commensurate in scope with the instant claims. The only apparent evidence that could possibly show an unexpected result is for formation of a two-layer image of white toner over black toner. The instant claims are directed to the white toner (claim 1) and developer (claim 11) containing this toner but not a construction of the two-layers as presented in the declaration. The declaration makes clear that the toner by itself does not produce an unexpected result in shielding property as compared to the prior art noting the inventive and comparative examples for one-layer images (also see recent response p. 2, second full paragraph). The white toner (and developer) of the instant claims can clearly be used where it only forms a one-component layer, such as where a white toner produces an image on a colored sheet of paper (e.g., red, black, etc.). Thus, the white toner is not limited to the two-layer construction (white + black) for its usefulness. The declaration is also limited to a white + black image and provides no evidence or reason to believe that the same result would be obtained for a white + other color toner. The evidence is clearly not commensurate in scope with the instant claims.

Because the significance of the evidence has not been established and because the evidence is not commensurate in scope with the instant claims, the rejections of record are maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher D RoDee whose telephone number is 571-272-1388. The examiner can normally be reached on most weekdays from 6 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-0661.



cdr
20 January 2004

CHRISTOPHER RODEE
PRIMARY EXAMINER